

REMARKS

This Amendment is filed in response to the Non-Final Office Action dated November 9, 2007. All rejections and objections are respectfully traversed.

Claims 35-135 are currently pending.

Claims 91 and 115 have been amended to correct typographical errors.

Claim Objections

On page 2 of the Office Action, the Examiner objected to claims 91 and 115 due to informalities. By way of this Amendment, Applicant has corrected these informalities. Applicant thanks the Examiner for pointing out these informalities.

Rejections Under 35 U.S.C. §103

At paragraph 4 of the Office Action, the Examiner rejected claims 35-135 under 35 U.S.C. §103(a) as being unpatentable over AddressMate for Windows Version 2.0 (“AddressMate”) software product box in view of U.S. Patent No. 5,859,636 (“Pandit”). Applicant respectfully traverses this rejection.

User Manual For AddressMate and AddressMate Plus

Applicant notes that User Manual For AddressMate and AddressMate Plus (“User Manual”) describes the operation of the AddressMate software product in more detail than the AddressMate software product box. During the trial of *Arendi v. Microsoft*, which involved U.S. Patent No. 6,323,853, (the parent of the present application), David

Block, the creator of the AddressMate software product, testified that the User Manual pertains to AddressMate 2.0. In particular Mr. Block testified as follows:

A. YES. WE HAD TWO PRODUCTS ON THE MARKET AT THE SAME TIME. WE HAD ADDRESSMATE VERSION 2.1 SOMETHING-OR-OTHER, AND WE HAD ANOTHER PIECE OF SOFTWARE THAT WE SOLD AT ADDRESSMATE PLUS, WHICH WAS ACTUALLY THE SAME EXACT CODE BASE EXCEPT WE CHANGED THE DLL IN THE 2.0 VERSION OF THE DLL THAT SAID IF YOU WANT TO DO ADDRESS CORRECTION -- I'M SORRY.

IN THE ADDRESSMATE 2.0, THERE WAS A DLL THAT SAID IF YOU WANT TO DO ADDRESS CORRECTION, YOU COULD UPGRADE TO ADDRESSMATE PLUS. ADDRESSMATE PLUS ALWAYS CAME WITH THE CD.

(Trial Transcript of September 21, 2004 on page 95)

The trial transcript has been cited to, and considered by, the Examiner in an Information Disclosure Statement filed on January 3, 2005 and initialed by the Examiner on October 23, 2007. Furthermore, a copy of the User Manual has previously been cited to, and considered by, the Examiner in an Information Disclosure Statement filed on February 10, 2004 and initialed by the Examiner on May 14, 2004.

Mr. Block makes clear that he is the creator of the program, and the responsible for its marketing, see page 77 of the trial transcript of Sept 21, 2004.

Q. NOW, YOU MENTIONED THE ADDRESSMATE SOFTWARE COMPANY. WHAT WAS YOUR POSITION THERE?

A. AS I SAID, I STARTED THE COMPANY, I WAS THE PRESIDENT, I WAS ALSO THE DEVELOPER, THE DESIGNER, THE PROGRAMMER, THE CHIEF MARKETING PERSON, THE SHIPPING

CLERK AND EVERYTHING IN BETWEEN.

Also, Mr. Block testified on page 111 that:

Q. AND WHAT IS THAT MANUAL?

A. IT IS THE USER MANUAL THAT WAS SHIPPED WITH BOTH ADDRESSMATE AND ADDRESSMATE PLUS, SO THE USER WOULD KNOW WHAT THEY COULD DO WITH THE PRODUCT AND HOW IT WORKED.

Q. AND HOW DO YOU KNOW THAT?

A. I WROTE THE ORIGINAL VERSION.

The User Manual came in the box with AddressMate and AddressMate Plus (AddressMate Plus was also called AddressMate 3.0). AddressMate Plus, with its box and the manual was part of what was called Exhibit X-15 at the trial.

On this, Mr. Block stated in the same trial transcript on page 111:

Q. ... ON WHAT'S BEEN MARKED AS EXHIBIT X-15, YOU NOTED THAT THERE IS A USER MANUAL; IS THAT RIGHT?

A. THAT'S CORRECT.

Q. AND WHAT IS THAT MANUAL?

A. IT IS THE USER MANUAL THAT WAS SHIPPED WITH BOTH ADDRESSMATE AND ADDRESSMATE PLUS, SO THE USER WOULD KNOW WHAT THEY COULD DO WITH THE PRODUCT AND HOW IT WORKED.

And further, Mr. Block further stated on page 127:

Q. I WOULD LIKE TO SHOW YOU WHAT'S BEEN MARKED AS EXHIBIT X-15, AND THAT'S THE SOFTWARE BOX.
MR. BLOCK, DO YOU RECOGNIZE WHAT'S BEEN HANDED

- TO YOU, WHICH HAS BEEN MARKED AS EXHIBIT X-15?
- A. I DO.
- Q. AND WHAT IS IT?
- A. THIS IS A COPY OF THE BOX WITH -- APPARENT CONTENTS
IN IT OF ADDRESSMATE PLUS, WHICH WAS ALSO KNOWN AS
ADDRESSMATE VERSION 3.0

As noted above, that the only difference between AddressMate 2.0 (to which the box pertains) and AddressMate 2.1 and AddressMate 3.0 was related to address correction. Moreover, the quote above makes clear that AddressMate 3.0 is simply another name for AddressMate Plus. Therefore the User Manual for AddressMate and AddressMate Plus describes the functionality of the software in all respects with respect to address correction, which was handled in AddressMate Plus. This means that the User Manual describes all functionality of AddressMate 2.0 plus the added functionality that appeared in AddressMate Plus.

Argument in Response to Rejection

The User Manual provides a more accurate instruction as to the actual operation of the AddressMate software product.

Illustrative claim 35 includes the element of:

marking without user intervention the first information to alert the user that the first information can be utilized in a second application program

Illustrative claim 70 includes the elements of:

identifying without user intervention or designation the first information; and

responding to a user selection by inserting a second information into the document, the second information associated with the first information from a second application program.

As described in the User Manual on page 6-44, to retrieve an address, the user must:

“1. Type part of the address you want to retrieve... 2. Using the mouse, drag through the address information you typed to select it. (If no text is selected, the text to the left of the cursor will be used for the search.)...3. Choose the *Amate/Retreive* command.”

Thus, the AddressMate program requires that the user select the text to be searched, either by highlighting the text (i.e., dragging through the address using the mouse) or by placing the cursor to the right of the desired text. In this way, the AddressMate program is similar to the Tso reference which the Examiner has indicated the claims are allowable over. For example in Tso, column 4, lines 32-45, states that a user designates a “text string to be processed, for example, by clicking on it.” Alternately, the designation “could be accomplished by appropriately positioning a cursor using a touch keypad and pressing an ‘ENTER’ key.” Thus, similar to the Pandit and Tso references, a user must manually intervene in the AddressMate program to designate the desired first information.

The Examiner indicates that by combining the AddressMate and Pandit references, the claimed invention is rendered obvious under 35 U.S.C. §103. Applicant respectfully traverses this rejection. In Pandit, the user must specifically highlight or select the text (first information) before it is “recognized as belonging to a predetermined class and performing an operation relevant to the recognized text” See, col. 1, lines 51-53. Pandit reference uses the words accent, highlight or indicate to describe the user intervention required. See, e.g., Fig. 2, step 21. For example, in col. 2, lines 8-9, Pandit states that “[t]he invention recognizes the accented text.” Additionally, in col. 2, lines 32-35, Pandit further states that “[t]he pull-down menus provided by the invention identify the operations and/or programs which relate to the class of text accented, highlighted or otherwise indicated.” Thus, Pandit teaches a system where the user must select text prior to the system processing the “a selected text”, e.g. col. 5, line 56).

Neither the AddressMate program nor Pandit teach the element of “marking without user intervention “ or “identifying without user intervention or designation the first information” either alone or in combination. The combination of AddressMate and Pandit is similar to the combination of Tso and Pandit previously argued in this application.

Furthermore, the description of the AddressMate program contained within the AddressMate reference is a marketing reference that does not sufficiently enable one skilled in the art to implement the invention.

Similar claim elements appear in the other independent claims of this application. These claims should be allowable for the same reason as stated above in reference to claims 35 and 70.

All dependent claims are believed to be allowable at least because they depend from an allowable base claim.

Conclusion

All claims are believed to be in condition for allowance.

Please charge any additional fee occasioned by this paper to our Deposit Account

No. 03-1237.

Respectfully submitted,

/Duane H. Dreger/
Duane H. Dreger
Reg. No. 48,836
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210
Telephone: (617) 951-2500
Facsimile: (617) 951-3927